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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/611,656   | 06/30/2003  | Philip T. Mellinger  | 020375-029210US     | 1992             |
| 20350 7590 02/20/2009<br>TOWNSEND AND TOWNSEND AND CREW, LLP<br>TWO EMBARCADERO CENTER<br>EIGHTH FLOOR<br>SAN FRANCISCO, CA 94111-3834 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| ZIA, SYED  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 2431   |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/611,656

**Applicant(s)**

MELLINGER ET AL.

**Examiner**

SYED ZIA

**Art Unit**

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to application filed on June 30, 2003. Original application contained Claims 1-24. Therefore, presently Claims 1-24 are pending.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-24 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 AFCE (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the

apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lineman et al. (U. S. Publication No.: 2003/0065942).

3. Regarding Claim 1, Lineman teaches and describes a method for implementing a security risk assessment for a merchant entity having connectivity to a shared network, the method

comprising: receiving, from each of a plurality of payment-processing organizations, a set of security requirements defining protocols for implementing commercial transactions over the shared network using instruments identified with the payment-processing organization; developing a security test scheme having a set of test requirements whose satisfaction by the merchant entity is sufficient to ensure compliance with the sets of security requirements defined by each of the plurality of payment-processing organizations; and performing a remote scan of a network site maintained by the merchant entity on the shared network in support of shared-network commercial transactions with a security compliance authority server, the remote scan implementing at least a subset of the set of test requirements to evaluate compliance by the merchant entity ([0036-0039, and 0078-0096]).

4. Regarding Claim 12, Lineman teaches and describes a method for assessing a security risk for a merchant entity having connectivity to a shared network, the method comprising: receiving information describing characteristics of the merchant entity from the merchant entity; determining which test requirements of a security test scheme to use in assessing the security risk for the merchant entity, wherein the security test scheme includes a set of test requirements whose satisfaction by the merchant entity is sufficient to ensure compliance with a plurality of sets of security requirements defined by a plurality of payment-processing organizations; and executing the security test scheme with a security compliance authority server in accordance with the determined test requirements ([0036-0039, and 0078-0096]).

5. Regarding Claim 21, Lineman teaches and describes a computer-readable storage medium having a computer-readable program embodied therein for direction operation of a security compliance authority server including a communications system, a processor, and a storage device, wherein the computer-readable program includes instructions for operating the security compliance authority server to assess a security risk for an merchant entity having connectivity to a shared network in accordance with the following: receiving, with the communications system, information describing characteristics of the merchant entity; determining, with the processor, which test requirements of a security test scheme to use in assessing the security risk for the merchant entity, wherein the security test scheme is stored on the storage device and includes a set of test requirements whose satisfaction by the merchant entity is sufficient to ensure compliance with a plurality of sets of security requirements defined by a plurality of payment-processing organizations; and executing, with the processor, the security test scheme in accordance with the determined test requirements ([0036-0039, and 0078-0096]).

6. Claims 2-11, 13-20, and 22-24 are rejected applied as above rejecting Claims 1, 12, and 21. Furthermore, Lineman teach and describe a method and apparatus for establishing a security policy wherein:

As per Claim 2, further comprising transmitting a questionnaire to the merchant entity with the security compliance authority server, the questionnaire including queries whose truthful response identifies a level of compliance with at least some of the test requirements ([0084-0086]).

As per Claim 3, further comprising scheduling an on-site audit at the merchant entity with the security compliance authority server, the on-site audit being structured to follow a prescribed methodology for identifying a level of compliance with at least some of the test requirements ([0084-0088]).

As per Claim 4, a satisfaction level of the test requirements required for compliance with the test requirements is dependent on a characteristic of the merchant entity ([0087-0091]).

As per Claim 5, the characteristic comprises a shared-network transaction volume processed by the merchant entity over the shared network ([0090]).

As per Claim 6, a frequency of performing the remote scan is dependent on a characteristic of the merchant entity ([0093-0094]).

As per Claim 7, the characteristic comprises a shared-network transaction volume processed by the merchant entity over the shared network ([0090]).

As per Claim 8, further comprising receiving information describing characteristics of the merchant entity from the merchant entity to limit parameters of the remote scan ([0092-0094]).

As per Claim 9, further comprising generating a report summarizing a level of compliance by the merchant entity with the set of test requirements as determined from performing the remote scan ([0083-0096]).

As per Claim 10, the merchant entity comprises an Internet merchant ([0025-0029]).

As per Claim 11. The method recited in claim 1 wherein the merchant entity comprises an Internet merchant gateway ([0025-0029]).

As per Claim 13, executing the security test scheme comprises performing a remote scan of a network site maintained by the merchant entity on the shared network in support of shared-network commercial transactions with the security compliance authority server ([0078-0088]).

As per Claim 14, executing the security test scheme comprises scheduling an on-site audit at the merchant entity with the security compliance authority server, the on-site audit being structured to follow a prescribed methodology for identifying a level of compliance with at least some of the test requirements ([0078-0088]).

As per Claim 15, executing the security test scheme comprises transmitting a questionnaire to the merchant entity with the security compliance authority server, the questionnaire including queries whose truthful response identifies a level of compliance with at least some of the test requirements ([0078-0088]).

As per Claim 16, determining which test requirements of the security test scheme to use in assessing the security risk for the merchant entity is dependent on a characteristic of the merchant entity ([0087-0091]).

As per Claim 17, the characteristic comprises a shared-network transaction volume processed by the merchant entity over the shared network ([0088-0090]).

As per Claim 18, further comprising generating a report summarizing a level of compliance by the merchant entity with the set of determined test requirements as evaluated from executing the security test scheme ([0072-0091]).

As per Claim 19, the merchant entity comprises an Internet merchant ([0025-0029]).

As per Claim 20, the merchant entity comprises an Internet merchant gateway ([0025-0029]).



As per Claim 22, the instructions for executing the security test scheme comprise instructions for performing a remote scan of a network site maintained by the merchant entity on the shared network in support of shared-network commercial transactions ([0072-0091]).

As per Claim 23, the instructions for executing the security test scheme comprise instructions for scheduling an on-site audit at the merchant entity ([0072-0091]).

As per Claim 24, the instructions for executing the security test scheme comprise instructions for transmitting a questionnaire to the merchant entity ([0072-0091]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SYED ZIA whose telephone number is (571)272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sz

February 12, 2009

/Syed Zia/

Primary Examiner, Art Unit 2431